

**REMARKS**

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

Claims 1-20 were originally filed with this application. Claims 11-20 are drawn to an unelected invention. Therefore, claims 1-10 are currently pending and subject to examination.

In the Office Action mailed May 8, 2003, the Examiner rejected claims 1-10 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,995,359 to Klee et al., and further in view of U.S. Patent No. 6,258,459 to Noguchi, et al., and Japanese Patent Abstract Publication No. 10-189887. To the extent that this rejection might still be applied to the claims currently pending, it is respectfully traversed as follows.

The Applicants respectfully submit that none of the cited prior art, nor combination thereof, teaches or suggests the combination of an  $\text{ReO}_3$  layer having a (001) orientation and an oxide ferroelectric layer having a perovskite structure, said oxide ferroelectric layer being formed on said  $\text{ReO}_3$  layer and having a (001) orientation, as claimed in claim 1. In particular, the Applicants submit that Noguchi fails to teach or suggest at least the feature of providing an  $\text{ReO}_3$  layer, as the Examiner admits (the Examiner merely asserts the disclosure of contacting rhenium oxide electrodes). The Applicants further submit that Noguchi does not teach forming a  $\text{Y}_2\text{O}_3$  layer in the absence of a 900° C environment.

The Applicants further respectively submit that, in contrast to the Examiner's assertion, Klee does not teach or suggest that an (001) orientation could typically be

employed in such a device (it is noted that the Examiner cites to Noguchi for this assertion, rather than Klee).

The Applicants submit that none of the cited references discloses or suggests providing the specific layers, with the indicated orientation, as claimed in claim 1, nor formation in the absence of 900° C environment, the presence of which the Applicants submit will affect the semiconductor device structure of the substrate.

For at least the above reasons, the Applicants submit that claim 1 is allowable over the cited prior art. As claim 1 is allowable, the Applicants submit that claims 2-10, which depend from allowable claim 1, are likewise allowable over the cited prior art.

Further, with regard to the rejection under § 103, applicant submits that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under § 103 to establish a prima facie case of obviousness. In re Fine, 5 USPQ2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself has made clear that where a modification must be made to the prior art to reject or invalidate a claim under § 103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could be modified to meet the claim is insufficient to establish obviousness. The PTO "can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so).

In the Office Action, the Examiner merely states that the motivation for combining the references is found in certain advantages stated by the Examiner (see, e.g., page 4, second full paragraph). The Examiner, however, indicates nothing from within the applied references to evidence the desirability of this combination.


In view of the foregoing, reconsideration of the application is respectfully requested. Withdrawal of the outstanding rejections, allowance of claims 1-10, and the prompt issuance of a Notice of Allowability are respectfully solicited.

If this application is not in condition for allowance, the Examiner is requested to contact the undersigned at the telephone listed below.

In the event this paper is not considered to be timely filed, Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300.

Respectfully submitted,

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